

REMARKS

In response to the rejection of claims 2, 5, 6, 8 and 11 under 35 USC 112, second paragraph, applicant has amended the claims to provide antecedent basis for the terms questioned by the Examiner. Applicant has incorporated the limitations of claim 7 into claim 11 and has canceled claim 7. New claim 13 is directed to the feature disclosed at page 3, lines 28-29, of the specification. No new matter has been added. Applicant respectfully traverses the rejection as stated with respect to claim 2, since the Examiner failed to point out where in claim 2 there are any antecedent basis issues and applicant sees none. Applicant has also amended the claims to recite the invention in more positive terms. Claims 2-6 and 9-13 will be pending upon entry of these amendments. Entry of these amendments and withdrawal of the rejection under 35 USC 112, second paragraph, are respectfully requested.

The incorporation of claim 7 into claim 11 overcomes the rejection of claims 2-6, 8, 9 and 11 as anticipated by Zubok. The obviousness rejections of claims 10 and 12, which rely on Zubok as disclosing the limitations of unamended base claims 2 and 11, are likewise moot in light of this amendment.

Claim 7 was rejected under 35 USC 103(a) on Zubok in view of Errico. The Examiner found that Zubok does not disclose the requirement of claim 7, now incorporated into claim 11, that the width of the prosthesis be at least 1.5 times its depth, citing Errico paragraph [0016] as disclosing that relationship. This rejection and its supporting reasoning are respectfully traversed.

The term "depth" in claim 7 as filed was intended to refer to the anterior to posterior dimension of the prosthesis in an implanted position. This is clear from FIG. 1 and page 3, lines 25-29, of the specification. Claim 11 explicitly recites this dimension. Errico paragraph [0016], the portion of Errico to which the Action refers, ostensibly refers to this dimension as well. However, the full context of Errico demonstrates that the "depth" discussed in paragraph [0016] of Errico is not the depth recited in the claims of this application.

Paragraph [0016] does not state explicitly what it means by “depth,” nor does paragraph [0063], which parallels paragraph [0016]. It is not clear from those paragraphs, nor from FIGS. 1g-1n to which they refer, to which dimension of the artificial disc the term “depth” refers. Since one of the common meanings of the word “depth” is “the perpendicular measurement downward from a surface,” *Webster’s Ninth New Collegiate Dictionary* 341 (1990), it is at least plausible that paragraphs [0016] and [0063] use the word “depth” to refer to the distance from the top surfaces of the vertebral discs to their bottoms.

The solution to this question becomes apparent when one considers paragraphs [0027], [0106] and [0109] of Errico. Paragraph [0106] refers to the separation of upper and lower halves 306a and 306b in a dynamic trial as depicted in FIGS. 3a-d. Referring to FIG. 3a, one can see that the instrument acts to separate the upper and lower prosthesis plates. In paragraph [0109], Errico refers to distracting the intervertebral space to “a depth that is at least equal to the depth of the closed bifurcated trial 304”; the act of “distracting” is pulling the vertebrae apart to allow for fitting of the prosthesis halves. Finally, paragraph [0027] indicates that “markings are provided on the inner shaft portion to quantify *the depth* (to which the bifurcated trial has been expanded) corresponding to the distance that the outer shaft has been translated with respect to the inner shaft portion.” [Emphasis added.] Accordingly, the reference in Errico to “depth” must in context refer to the distance from the top surface to the bottom surface of the vertebral discs, not the distance from the front to the back of those discs.

Once one reads Errico’s disclosure correctly in its context, one sees that the “depth” dimensions to which Errico refers do not correspond to the claimed “depth” dimensions and cannot be used to derive a teaching of the claimed width to depth ratios of the vertebral discs. As the Examiner well knows, it is impermissible to derive dimensions from reference drawings, so there is nothing in Errico to support the Examiner’s use of it to reject the pending claims. Accordingly, the rejection of claim 7 under 35 USC 103(a) on Zubok in view of Errico should be

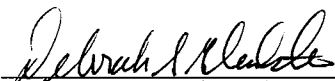
withdrawn, and claim 11 as amended should be allowed. Since the remaining claims pending in this application depend directly or indirectly from allowable claim 11, they are allowable as well.

Early action allowing claims 2-6 and 9-13 is solicited.

In the event that the transmittal letter is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. 246472008500.

Respectfully submitted,

Dated: October 3, 2007

By:  #43636
Barry E. Bretschneider
Registration No. 28,055

Morrison & Foerster LLP
1650 Tysons Boulevard, Suite 400
McLean, Virginia 22102
Telephone: (703) 760-7743
Facsimile: (703) 760-7777